

Appl. No. 10/706,392
Amdt. dated September 9, 2005
Reply to Office action of July 11, 2005

REMARKS/ARGUMENTS

Claims 1-8 are presently pending in the application as set forth in the Amendment A filed May 18, 2005..

In this amendment, Claims 1 and 8 have been amended.

Claims 9-12 have been added.

Claims 2, 3, 6, 7 remain unchanged.

Claims 4-6 have been withdrawn and also remain unchanged.

This amendment is set forth to comply with the Examiner's requirements or to otherwise place the application for condition for allowance or for consideration on appeal. This amendment is thus believed to comply with the requirements of 37 C.F.R. 1.116. Entry of the amendment is thus respectfully requested.

As set forth below, the amendments to the Claims are believed to place the Claims in condition for allowance. In view of the amendments, as discussed below, reconsideration of the Application and issuance of a Notice of Allowability are respectfully requested.

Rejection Under 35 U.S.C. §102

The Examiner has continued his rejection of the Claims 1-3 and 6-8 under 35 U.S.C. §102(b) as being anticipated by West (Pat. No. 6062045).

Initially, and as discussed in the prior amendment, West was solving a substantially different problem than Applicant is solving in his present invention. As set forth at Col. 8,

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lines 17-24, West was solving the problem of providing highly wear resistant jewelry. As set forth thereat:

"The principal concept of this invention is the provision of an ultra durable hard metal or high tech ceramic type of jewelry that may or may not incorporate precious metals and/or precious gem stones. The invention also provides a unique jewelry manufacturing process that combines hard metals with precious metals in a manner such that the precious metals are flush or recessed slightly below the outer most surfaces of the hard metals over the outer wear surfaces to achieve maximum abrasion and corrosion resistance."

To this end, West, in FIG. 5 shows a band of precious metal being received in a groove in ring. Applicant, on the other hand, is solving a substantially different problem which is not solved by West – namely, (1) the securing of a copper alloy decoration in an inlay area of the ring (or other item of jewelry) to prevent the decoration from protruding from the jewelry and (2) providing a copper alloy that, once tarnished from oxidation, can be polished to recover the original color of the decoration.

To anticipate Applicant's claimed invention, "the identical invention must be shown in as complete detail as is contained in the ... claim". MPEP §2131, *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Hence, West must show each and every feature set forth in the rejected claim. However, West does not teach the copper alloy set forth in Claim 1.

The Examiner asserts that West's recitation that "a selected precious metal and/or other forms of material" which can be inlaid in the groove provides support for the anticipatory rejection of Claim 1. While West discloses that various materials may be used

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in the groove, West does not teach or suggest the *claimed alloy* as set forth in Claim 1, namely, an alloy "consisting essentially of 6 to 15 weight percent copper and 94 to 85 weight percent gold". Because West does not disclose the claimed alloy, West cannot anticipate Claim 1 as currently set forth.

What the Examiner has done, in effect, is reject a species with a genus. However, as set forth in MPEP 2131.02, this is not proper. MPEP 2131.02 states that "a genus does not always anticipate a claim to a species within the genus." MPEP 2131.02 goes on to state that:

"When the compound is not specifically named [in the reference], but instead it is necessary to select portions of teachings within a reference and combine them, e.g., select various substituents from a list of alternatives given for placement at specific sites on a generic chemical formula to arrive at a specific composition, anticipation can only be found if the classes of substituents are sufficiently limited or well delineated. *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). If one of ordinary skill in the art is able to "at once envisage" the specific compound within the generic chemical formula, the compound is anticipated. One of ordinary skill in the art must be able to draw the structural formula or write the name of each of the compounds included in the generic formula before any of the compounds can be "at once envisaged." One may look to the preferred embodiments to determine which compounds can be anticipated. *In re Petering*, 301 F.2d 676, 133 USPQ 275 (CCPA 1962)" (emphasis added)

However, West's mere recitation that "other forms of material" can be used does not contain a description which would sufficiently limit or delineate the copper alloy as set forth in Claim 1. Hence, the copper alloy set forth in Claim 1 cannot "be at once envisaged" by one of ordinary skill in the art based on the teachings of West. Thus,

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Applicant respectfully points out that West does not anticipate Claim 1 or the claims which depend therefrom.

Because West does not teach the claimed alloy composition, West, as noted cannot anticipate Claim 1. Thus, at best, West can be used to support a rejection of Claim 1 under §103. However, West does not make the claimed invention obvious. In addressing the alloy composition, the Examiner states:

"It would also be readily understood and appreciated by those of ordinary skill in the art, of the known aptitude to combine varying percentages of different metals for purposes of obtaining different color schemes, and utilizing the different physical properties of each metal individually as well as the result combined, such as corrosion and hardness characteristics of a jewelry item".

This statement by the Examiner amounts to an "obvious to try" rejection of the alloy set forth in the claim. As set forth in MPEP §2145.X.B, an "obvious to try" rejection is improper without some suggestion to modify the prior art. Here, the Examiner has not provided any suggestion or motivation to modify the teachings of West to use Applicant's alloy. Without any suggestion as to the desirability to use the alloy set forth in Claim 1, West cannot make obvious the invention of Claim 1.

Further, as noted above, West solves a substantially different problem than Applicant. As set out in the excerpt above from West, West was solving the problem of providing an ultra durable hard metal or high tech ceramic type of jewelry. That is, West was providing the material from which a ring, pendant, etc. can be made. Applicant, on the other hand, is providing an alloy for use in decorating jewelry that has unique color

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characteristics, as set forth at page 2 of the substitute specification. Thus, the West reference is in a different field from Applicant's endeavor. Although the West reference is in a different field, it could still be analogous prior art if it would be reasonably pertinent to the particular problem with which the inventor was concerned. To be pertinent, the reference must be one which logically would have commended itself to an inventor's attention in considering his problem. MPEP §2141.01(a) and cases cited therein. One trying to produce an alloy for jewelry inserts or decorations with particular color characteristics would not logically be expected to examine art related to the strength of the alloy used for making jewelry. Applicant thus respectfully asserts that West is non-analogous prior art and respectfully requests that it be removed as prior art. MPEP §2141.01(a).

For at least the forgoing reasons, Claim 1 is believed to be allowable over the West patent. Claims 2-3, 6 and 7 depend from Claim 1 and are similarly believed to be allowable.

At page 7 of the office action, the Examiner recommended focusing on the structure of the jewelry. Claim 8 has thus been amended to further describe the structure of the inlay area which receives the decorating part. Applicant also points out that some of the "product by process" elements that were originally set forth in Claim 8 have been removed. Claims 9-12 have been added to further describe the structure of the inlay area. The structure of the inlay area as described in FIGS. 8-12 is shown in FIG. 2A of the

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application. Hence, the amendment to Claim 8 and the insertion of new Claims 9-12 do not add new matter to the application.

None of the references, whether considered individually or in combination teach or suggest the item of jewelry as set forth in Claim 8. In particular, none teach a piece of jewelry with an inlay area having the shape or structure as set forth in Claims 8-12. Hence Claims 8-12 is believed to be allowable over the art of record.

In view of the foregoing, Claims 1-3 and 6-12 are believed to be in condition for allowance. A Notice of Allowability with respect to these claims is thus respectfully requested.

Respectfully Submitted,

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Jonathan P. Soifer, Reg. No. 34,932
Folster, Lieder, Woodruff & Lucchesi, L.C.
12412 Powerscourt Drive, Suite 200
St. Louis, Missouri 63131
Tel: (314) 238-2400
Fax: (314) 238-2401
e-mail: jsoifer@patpro.com

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